

subsequently machining said laminate coated carrier into one or more floor profiles, which may be the same or different cross-section, said profiles being selected from the group consisting of dilation profile, transition profile and finishing profile, from the laminate coated carrier to produce a floor strip.

Claim 9, line 1, change "1" to --7--.

#### REMARKS

Reconsideration of the rejections set forth in the Office Action mailed July 8, 1998, are respectfully requested in view of the foregoing Amendment and the following comments.

It is noted that the examiner has rejected claims 3-4 and 6-14 under 35 USC 112, 2<sup>nd</sup> paragraph, allegedly as being indefinite. The examiner has indicated that such process claims are replete with indefiniteness.

Applicant respectfully disagrees that such claims are indefinite and believes that the examiner is making hypertechnical arguments. For example, with regard to independent claim 7, which is directed to "a process," the examiner urges that the step "comprises gluing . . ." is allegedly indefinite in either defining the floor strip or the process. By use of the gerund "gluing," it clearly is a process step and not a structural limitation of a floor strip.

However, notwithstanding the examiner's late raising of these allegations of indefiniteness, independent claim 7 has been amended to more particularly point out and distinctly claim the subject matter which applicants regard as the invention, as well as to correct a typographical error in the spelling of the word "carrier." Claim 9 has also been amended to make it depend from independent claim 7. Accordingly, the foregoing Amendment neither raises the issue of new matter nor new issues and could not have been earlier presented as it responds to issues first raised by the examiner in the Final Rejection.

Reconsideration of the rejection of claims 3-4 and 6-14 under 35 USC 112, 1<sup>st</sup> paragraph, is respectfully requested.

The examiner has rejected these claims based on the allegation that the specification does not "clearly teach" what constitutes a dilation profile, transition profile, or finishing profile. Applicant believes that the examiner has misapprehended the teachings of the specification and applicant respectfully directs the examiner's attention to page 3, fifth full paragraph, and Figs. 2-4 accompanying the application in which Fig. 2 shows a dilation profile, Fig. 3 illustrates a finishing profile, and Fig. 4 shows a transition profile.

Moreover, even though applicant's specification as originally filed contains an adequate description complying with 35 USC 112, 1<sup>st</sup> paragraph, said profiles can also be found in publications known to those skilled in the art and, as evidence, applicant attaches a copy of page 43 from a publication known as *Original Pergo, The Free and Easy Floor*, published by Perstorp Flooring, Trelleborg, Sweden.

Accordingly, it is respectfully submitted that the rejection of claims 3-4 and 6-14 under 35 USC 112, 1<sup>st</sup> paragraph, is clearly untenable and should be withdrawn.

Claim 7 stands rejected under 35 USC 103(a) as being unpatentable over Munk et al (U.S. Patent 4,594,347) or, alternatively, claims 3-4 and 6-14 stand rejected under 35 USC 103(a) as being unpatentable over Munk et al (U.S. Patent 4,594,347) in view of Lindgren et al (U.S. Patent 4,940,503). Reconsideration of these rejections is respectfully requested.

Munk et al does not, as the examiner alleges, disclose a method of pressing an abrasion resistant laminate onto a fiber-board, but rather discloses a method of applying a transparent protective and/or decorative foil onto a pre-shaped fiber-board; See, Fig. 3 and the definition of F<sub>1</sub> as "a simple

paper sheet" in Munk et al at column 3, line 37. A second foil  $F_2$  is described by Munk et al as a melamine-formaldehyde thermosetting resin; column 3, lines 38-39. This has nothing in common with the claimed invention which discloses a method for production of profiles for flooring strips using a component which is an abrasion resistant, hard particle containing, postforming quality thermosetting laminate, which method comprises manipulative steps not taught nor made obvious by Munk et al alone or Munk et al in view of Lindgren et al.

In the claimed invention as defined, for example, in independent claim 7, a thin decorative thermosetting laminate of postforming quality which includes hard particles to impart an abrasion resistance to the laminate, measured as IP value of > 3000 revolutions is glued onto a longitudinal carrier having a rectangular cross section and at least two opposite rounded-off edges. The thermosetting laminate of postforming quality in one piece is glued on an upper side and on two long sides of the carrier via the rounded-off edges to form a laminate coated carrier and the process includes the step of subsequently machining such laminate coated carrier into a floor profile.

Therefore, when the examiner characterizes that Munk et al disclose a method of hot pressing synthetic-resin laminate, applicant queries where the examiner finds disclosure of a laminate. Munk et al clearly teaches using two foils ( $F_1, F_2$ ) but nowhere are these foils suggested to be a laminate. These are laminae. Munk et al does not disclose thermosetting laminates, having hard particles therein, of postforming quality, such that it may be glued in one piece onto the carrier, as clearly claimed in claim 7.

The examiner's reference to column 1, lines 54-56, is directed to a description of a "prior art" method which still teaches two laminae, i.e. two foils, which are separate, not a laminate; See column 1, lines 51-52. Moreover, there is no disclosure that the foils of this "prior art" (or even of Munk et

al) are not "wet," i.e. liquid resin containing laminae as opposed to a postfuming forming quality (i.e. a B-stage laminate) as in the claimed invention; See page 4, first full paragraph of the specification. Thus, there is clearly no laminate of the type employed by applicants, i.e. a thermosetting laminate of postforming quality. Certainly, the examiner recognizes that Munk et al does not include any hard particles and, thus, notwithstanding the examiner's conclusory statements in the first paragraph on page 5 of the Office Action, the Munk et al reference does not disclose the same process as that claimed by applicants and there is no reason to believe that the IP value of Munk would in any way overlap with that claimed. Even if the IP value of Munk et al did overlap, it is not clear that it would overlap by inclusion of hard particles, a step of the claimed invention not disclosed in the Munk et al reference.

Moreover, the examiner concedes that Munk et al does not contain any step of machining at all and certainly not machining the laminate into any dilation profile, transition profile or a finishing profile. Whether or not the profile taught by Munk et al in Figs. 1-4 is "sufficiently similar in shape" to the profiles disclosed in the instant invention does not make it obvious to include a machining step where none is taught or suggested as being desirable in Munk et al (alone or in combination with Lindgren et al). Moreover, the examiner does allege that eliminating the need for a mold as in Munk having a "special mold shape" would have been obvious, does not appear to make sense insofar as the examiner has just previously said that the profile taught by Munk in Figs. 1-4 is "sufficiently similar" to the profiles disclosed in the instant invention. Why, then, would one machine a profile as in the claimed invention when patentees, Munk et al, supposedly taught that the product can be molded into the finished shape. It, thus, appears that the examiner has found little, if any, relevant teaching in the Munk et al reference, but merely supposes that all the omitted features are either inherent (i.e. the IP

values "must" overlap) or well recognized even though there is no disclosure of a machining step.

Nevertheless, the examiner says that notwithstanding that Munk et al shows the same profile, which is produced by the machining step of applicant, it would be obvious to change the Munk et al mold to a flat mold and then incorporate a machining step. Such wishful thinking on the part of the examiner does not amount to a *prima facie* case of obviousness and clearly constitutes reversable error.

Accordingly, withdrawal of the rejection is respectfully requested.

The alternative rejection of Munk et al in view of Lindgren et al does not cure the foregoing deficiencies of Munk et al. Although Lindgren et al teach forming a laminate thermosetting melamine impregnated sheet and a decor sheet having a desired pattern and a covering sheet and further teaches inclusion of hard particles to increase the IP values, there is no teaching in Lindgren et al of using a thermosetting laminate of postforming quality, e.g. a so-called B-stage partially cured laminate which is glued onto a carrier as specified in the claimed invention. In this regard, applicants again direct the examiner's attention to the specification at page 4, first full paragraph. Thus, although Lindgren et al correctly teaches the provision of forming decorative thermosetting laminates, it is no way suggests the use of such a laminate for the production of a profile by gluing that laminate onto a carrier as specified in the independent claim and then machining the resulting laminate coated carrier to produce a floor profile as specified in independent claim 7.

Furthermore, as neither Munk et al nor Lindgren et al provide any reason why one would wish to make floor strips having high abrasion resistance, there is no motivation (absent that provided by applicant's disclosure) to impel one skilled in the art to do what applicant has done. In other words, there is no reason to make the proposed combination of Munk et al in view of Lindgren et al except

for the suggestion provided by the instant disclosure. Accordingly, the proposed combination of Munk et al and Lindgren et al fail to establish a *prima facie* case of obviousness.

In view of the new ground of rejection first raised in the Final Rejection, applicant respectfully submits that this Amendment should be entered as he could not have earlier responded to the issues raised by the examiner in the Final Rejection and, in any event, this response does not raise the issue of new matter nor new issues. Accordingly, entry of the Amendment for purposes of appeal is respectfully requested.

Having fully responded to the previous Office Action, favorable reconsideration and withdrawal of all rejections and passage of the application to issue are respectfully requested.

Respectfully submitted,



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